

Application No. 10/658,874

REMARKS

The Examiner's restriction requirement under 35 U.S.C. 121 is respectfully traversed since it is not believed that the Examiner has provided sufficient basis establishing that an undue burden would be placed on the U.S. Patent and Trademark Office to allow Claim 22 to remain in the present application, which claim is directed to a process for the preparation of the carrier particles. Furthermore, as the Examiner will note, the 6,391,509 patent being applied contains both the carrier composition claims and a process for the preparation thereof, see for example Claim 26 of U.S. Patent 6,391,509.

Accordingly, it is respectfully urged that the Examiner reconsider his position and rejoin Claim 22 into the present application.

Nevertheless, as requested by the Examiner, Applicants confirm their provisional election of the Group 1 Claims 1 to 21 and 23 to 29.

The rejection of Claims 9 and 16 under 35 U.S.C. 112 is respectfully traversed, particularly since the claims are directed to one of ordinary skill in the art. Nevertheless, Claim 9 has been amended as indicated, and Claim 16 has been amended to refer to the tetrafluoroethylene as a polymer as suggested by the Examiner.

The rejection of Claims 1 to 6, 9 to 21, 23, 24, 26 and 29 under 35 U.S.C. 102(b) as being anticipated by Drappel et al. 6,391,509 is respectfully traversed.

The Drappel et al. patent has been reviewed including the passages referred to by the Examiner, and the Examiner, in Applicants' view, has not established that each and every feature as recited in the rejected claims is disclosed in the '509 patent. More specifically, the Examiner has not shown that the carrier can contain a conductive polypyrrole or a conductive polyaniline in a carbon black matrix, it being noted that in column 8, beginning at line 61, of the '509 patent there is recited a conductive polyaniline, for example, doped or complex form with an organic acid, the Examiner pointing

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to no disclosure in columns 8 or 9, or the remainder of the patent wherein the polypyrrole or the polyaniline is contained in a carbon black matrix. Similar comments are applicable to Claim 9. Therefore, it is not believed that the rejected claims are anticipated as suggested by the Examiner.

With respect to the rejection of Claims 7 and 8 under 35 U.S.C. 103, the comments presented herein with respect to the Drappel et al. reference regarding the 35 U.S.C. 102 rejection is applicable. More specifically, Claims 7 and 8 depend on Claim 6, which in turn depends on Claim 1, and since the Examiner has not established with sufficient evidence or established sufficient motivation without the benefit of the teachings of the present application concerning the pyrrole being contained in the carbon black matrix, it is not believed that the rejection under 35 U.S.C. 103 of Claims 7 and 8 can be sustained.

The rejection of Claim 25 under 35 U.S.C. 103(a) as being unpatentable over Drappel et al. '509 patent in view of U.S. Patent 6,764,617 is respectfully traversed. The comments as recited herein with respect to the 103 rejection of Claims 7 and 8, and generally with respect to Drappel et al. are believed to be applicable, and accordingly will not be repeated. With respect to the secondary reference, since the primary reference fails in its teachings for the reasons as mentioned herein, the combination is not believed to be applicable. Moreover, the '617 patent is directed to a composition as suggested by the Examiner on page 6, there being no teaching therein with respect to the utilization of such composition as a carrier coating. Carrier technology is very complex and unpredictable, and accordingly undue experimentation would be involved in attempting to combine the '617 patent with the '509 patent, particularly without the benefit of the teachings of the present application and without a hindsight analysis approach.

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Accordingly, it is respectfully urged that the Examiner reconsider his positions and allow the present application.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby requested to call Eugene O. Palazzo, at Telephone Number 585-423-4687, Rochester, New York.

Respectfully submitted,


Eugene O. Palazzo
Attorney for Applicant(s)
Registration No. 20,881
(585) 423-4687

EOP/jah

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Xerox Corporation
Xerox Square 20A
Rochester, New York 14644